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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,507	12/29/2003	Sam Novinsky	P4510C1	7293

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EXAMINER

LEJA, RONALD W

ART UNIT PAPER NUMBER

2836

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,507

Applicant(s)

NOVINSKY ET AL.

Examiner

Ronald W Leja

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/29/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The Disclosure is objected to because of the following informalities: The Continuity Statement on Page 1 of the Specification needs to be updated to properly reflect the status of the Parent Application.

Appropriate correction is required.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

3. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 5 and 10 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 4 of prior U.S. Patent No.

6,670,729. This is a double patenting rejection.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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6. Claims 1-4, 6-9 and 11-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 4-6 and 8-10 of U.S. Patent No. 6,670,729. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Instant Claims 1-4 are anticipated by Patented Claims 1-3, Instant Claims 6-9 & 11 are anticipated by Patented Claims 4-6 & 7, and Instant Claims 12-16 are anticipated by Patented Claims 8-10.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1 and 2 are rejected under 35 U.S.C. 102(a) as being anticipated by Weynachter (6,127,742).

See Figure 8 and elements (23) & (34). See also Col. 6, lines 30-60.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 3, 6-8 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weynachter.

These set of claims essentially additionally require that the module (2) is a docking module for docking in a bay of a cabinet; Claims 6 and 12 essentially add that the cabinet has a redundant power supply/breaker modules. Claim 11 adds that the cabinet is dedicated to a packet router in the Internet. Weynachter teaches that the removable module (2) may be a switchgear, circuit breaker, a contactor or a switch with auxiliary control or indicating circuits. Also taught is that communication devices can also be disposed within the modules for use with a communication bus/network (see Col. 1, lines 20-52). See also Col. 7, lines 14-27. Armed with these general teachings and the common knowledge within the art, that related electrical equipment of a system are often housed together within a cabinet or rack setting, it is the opinion of the Examiner that it

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would have been obvious to utilize the modular teachings of Weynachter, wherein monitoring circuitry (23,34) is removed with the module's removal, to any bay of a cabinet and/or one having redundant power supplies, so as to reduce module replacement time by not having to re-establishing all the processing unit settings and configurations of the communication addresses each time a module is replaced. Use of redundant power supplies is well known in the art and would have been obvious to apply to a cabinet as a means to ensure continued power if a supply had failed.

11. Claims 4, 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weynachter as applied to Claims 1, 6 and 12 above, and further in view of Padulo (6,137,068).

These set of Claims are drawn to use of a safety mechanism for preventing the module from being docked or withdrawn with the breaker on. Padulo is also drawn to the "ensuring" that a removable circuit breaker is in the off position when removing or docking. Figure 3 illustrates a mechanism for ensuring the off position during docking procedures. Figures 4-8 also illustrate that a circuit breaker is in the off state when installing and removing. It would have been obvious to incorporate this safety feature as a means to protect the breaker's contacts as well as any equipment connected to the system from surge/arcing damages as a result of a breaker being inadvertently left on when removing or installing.

12. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form

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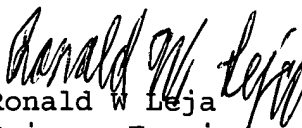
including all of the limitations of the base claim and any intervening claims AND UPON THE FILING OF A Proper Terminal Disclaimer.

13. The following is a Statement of Reasons for the Indication of Allowable Subject Matter: Claim 16 has added safety limitations drawn to a horizontal bar and notch system. Such limitations are not disclosed nor suggested by the Prior Art of Record, and as such, are allowable over the Prior Art of Record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald W. Leja whose telephone number is (571)272-2053. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (571)272-2800. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ronald W Leja
Primary Examiner
Art Unit 2836

rwl
February 6, 2005

